

### Remarks

#### Status of Claims

Claims 1-32 and 34 are pending in the application; all were finally rejected. Claim 1 and Claim 23 are the two independent claims.

Independent Claim 1 is currently amended. Support for the amendments made to Claim 1 is found on page 1 lines 14-16 of the specification and in Claim 4.

#### Summary of Invention

The subject matter set forth in the present application is a method of obtaining motor vehicle engine oil having user desired characteristics. According to Claim 1 of the present invention, a wide area computer network site is provided which allows a customer, in one of several ways, to participate in the design, selection or customization of a particular motor oil to fit that customer's needs. (specification pg 1, lines 14-16). The method more particularly obtains data from a user about the motor vehicle in which the engine oil is to be utilized. The user may enter information relating to environment of use, desired operational characteristics, average driving distance interest in fuel economy among other information. The data is analyzed by a computer and an oil is provided to the user that has the user desired characteristics.

Claim 23 provides a method of obtaining custom engine oil by: (a) using an implement to transmit information from a user about a user's motor vehicle type, environment of use, and desired operational characteristics, to a customized blending facility; (b) blending a custom engine oil using the information from (a); and (c) delivering to, installing or making available the custom engine oil. Both methods of Claim 1 and Claim 23 permit a customer to participate in the design, selection or customization of motor oil which has user desired characteristics.

#### Summary of Examiner's Rejection

All claims pending in the application were rejected by the Examiner under 35 USC 103(a) as being unpatentable over anonymous article "Telco, LML,

Apollo Tyres Tie up with Castrol," hereinafter "Telco," in view of one or more of U.S. Patent 6,182,048 ("Osborn"), U.S. Patent No. 4,954,273 ("Denis"), U.S. Patent Application Publication No.2001/0047309 ("Bartholomew"), and official notice of the Examiner.

The thrust of the Examiner's argument seems to be that a) motor oils containing additives to meet certain requirements are known; and b) collecting and analyzing data using a computer is known and therefore Applicants claimed method must be obvious. The Examiner improperly parsed the claim into its individual steps without viewing the invention as a whole. In determining the differences between the prior art and the claims, the question under 35 USC 103 is whether the claimed invention as a whole would have been obvious.

*Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983) See also *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976). The present invention is directed to a method of providing a motor oil having customer specified characteristics. When taken as a whole, there is nothing in the prior art to teach or suggest Applicants' claimed method by which customers can participate in the design, selection or customization of a particular motor oil to fit that customers needs. Presently, lubricants are designed by the industry not the consumer.

That being said, the Examiner appears to have lost site of the claimed invention. The invention described and claimed in the present application is directed to a method of doing business. The Examiner's rejections are directed to the patentability of the motor oil produced as a result of the business method. This is an incorrect analysis. The method permits the direct involvement of the consumer when designing a motor oil to suit their individual needs (See, Specification page 1). This business method is not obvious.

As shown in Fig 15 and discussed on page 15 of the Specification, if the consumer's needs are best met by the baseline motor oil then that is what will be delivered to the consumer. But, on the other hand, if the user desires enhancements to the motor oil – such as increased anti-wear or better fuel

economy – then a motor oil with those enhancements will be provided to the consumer. The fact the consumers needs may be met by “an existing mass-produced engine oil,” as argued by the Examiner on page 12 of the Final Rejection, is irrelevant to the issue of obviousness of the method described and claimed in the present invention. The method is not obvious because, unlike other methods of buying a motor oil, this method permits the customer to participate in the design, selection or customization of a particular motor oil to fit that customer's needs via analyzing data input by said customer.

Evidence that the outcome of the business method need not be novel or unobvious is found in recently issued US Pat No 6,948,169 to Dell directed to a web-based method of installing software onto a computer. There is no requirement that the software ultimately installed or the built-to-order computer be novel or unobviousness only that the method of obtaining the software is new and not obvious. The same argument applies here.

Summary of Applicants' Position with Respect to  
References Relied on by the Examiner

Applicants addressed each rejection to the pending claims in the Response to Office Action filed March 15, 2005. Applicants do not feel it is necessary to repeat all of the previous arguments and will therefore provide a summary of its view of the flawed arguments and references relied on by the Examiner.

Telco

The primary reference relied upon by the Examiner to establish a case for obviousness of Claim 1 and the claims that depend therefrom is Telco. The Examiner asserts that Telco discloses two aspects of Applicants' Claim 1; namely (c) providing a motor oil having *user desired enhancements* based on (a) data including type of information about the motor vehicle in which the engine oil is to be utilized sufficient to identify *a user's requirements*. (emphasis added)

The Examiner is just wrong. Telco does not address a user's particular requirements for a particular vehicle. The paragraphs in Telco cited by the

Examiner pertain to a deal between two large companies to provide motor oil designed by the industry supplier for an entire class of vehicles sold by the OEM. The reference does not provide a motor oil having user desired enhancements based on data about a particular user's motor vehicle.

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Telco teaches us that lubricants are typically provided to meet the needs of an OEM and their wide range of vehicles. Telco teaches away from allowing the customer to participate in the design, selection or customization of a particular motor oil to fit that customers needs. The lubricants in Telco, like those found in the marketplace as a whole, were designed by the industry not the customer.

#### Osborne

The Examiner relies on Osborne to argue step (b) of Applicants' Claim 1 obvious. Osborne is directed to a system and method for providing risk-based pricing for vehicle warranties. The Examiner relies on Osborne as evidence that data related to vehicles is collected and analyzed by computer. Osborne does not collect data for the purpose of allowing the consumer to design their own motor oil or even their own warranty. The invention must be considered as a whole and cannot be found obvious because the Examiner claims that individual steps, similar to those in the claimed invention, may be known. At the time the present invention was made, it was not known or obvious to obtain data from consumers to permit them to design a motor oil customized or enhanced to meet their individual needs.

#### Denis

The Examiner cites Denis to demonstrate that a variety of additives are known and are used to obtain different properties in a motor oil. That is an interesting argument but it is not relevant to an analysis of the claimed invention. The present invention is not claiming the composition of the motor oil, but the method of obtaining a customized motor oil to suit a consumer's needs. The

methods of Claim 1 and 23 are not obvious (as argued above) and therefore, the particulars of how the method is executed are also not obvious. (See Response to Office Action filed March 15, 2005 pgs 9-10).

Official Notice of Common Knowledge or Well-Know Prior Art

Contrary to Examiner's assertion on page 16 of the Office Action, Applicants do not admit that the Examiner's statements of "common knowledge" or "well-known in the art" are in fact prior art. The Examiner relies heavily and improperly on official notice of "common knowledge" or "well-known prior art" to fill the gaps in his argument in an attempt to create a prima facie case of obviousness. The Examiner cannot simply reach conclusions based on his own understanding or experience or on his assessment of what would be basic knowledge or common sense. See In re Zurko, 258 F.3d 1379, 1385. If the information relied upon by the Examiner are in fact common knowledge then the Examiner should provide evidentiary support for such arguments.

Bartholomew

Bartholomew is directed to a Nail Polish Color Selection System and Method. Bartholomew's priority is merely 12 days before Applicants' priority date and, if necessary, Applicants can swear behind the reference. However, Applicants do not believe it is necessary as evidenced by the arguments set forth in the previous Response to Office Action filed on March 15, 2005 pg 10.

In conclusion, the Examiner failed to establish a prima facie case of obviousness because the references do not teach or suggest all of the claim limitations of the present invention when the method is viewed as a whole. Accordingly, Applicants respectfully request that the Examiner enter the amendment to Claim 1 and allow pending Claims 1-32 and 34. If the Examiner refuses to allow the claims, Applicants request that the amendment be entered to put the rejected claims in better form for consideration on Appeal.

If the Examiner believes an oral or telephonic interview would advance the prosecution of this case, the Examiner is encouraged to contact Applicants' attorney at the Examiner's convenience.

**Correspondence Address:**

BP America Inc.  
Docket Clerk, BP Legal, M.C. 5East  
4101 Winfield Road  
Warrenville, Illinois 60555  
**Customer No. 04249**

Respectfully submitted,

  
Jennifer M. Hall

Attorney for the Applicants

Registration Number 38,169

(630) 821-2446